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10/054,425	01/22/2002	Ronald Magee	5151	5035

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EXAMINER

NERBUN, PETER P

ART UNIT

PAPER NUMBER

3765

DATE MAILED: 01/27/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/054,425

Applicant(s)

MAGEE ET AL.

Examiner

Peter P Nerbun

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-86 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-82 is/are allowed.
- 6) ☒ Claim(s) 83, 85 and 86 is/are rejected.
- 7) ☒ Claim(s) 84 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 January 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Claims 1-82 are allowed.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in - (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 83 and 85 are rejected under 35 U.S.C. 102(e) as being anticipated by Kent.

The patent to Kent discloses a computer-readable data transmission medium (within computer 68, Fig. 1) containing a data structure comprising instructions for patterning a textile substrate by the selective application of a plurality of colorants to the surface of said substrate through a set of individually-addressable colorant applicators (see col. 3, lines 47-58 and col. 4, lines 10-39), wherein said data structure comprises specification in computer-readable form, of values for a Product Specification Template. With regard to the recitation of a "Product Specification Template" note MPEP 2111 which states that "During patent examination, the pending claims must be "given their broadest reasonable interpretation consistent with the specification." *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000)...The court explained that "reading a claim in light of the specification, to thereby interpret limitations explicitly recited in the claim, is a quite different thing from 'reading limitations of the specification into a claim,' to thereby narrow the scope of the claim by implicitly adding disclosed limitations which have no express basis in the claim." The court found that applicant was advocating the latter, i.e., the impermissible importation of subject matter from the specification into the claim. See also *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997). The

court held that the PTO is not required, in the course of prosecution, to interpret claims in applications in the same manner as a court would interpret claims in an infringement suit. Rather, the "PTO applies to verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in applicant's specification.". In the instant application one having ordinary skill in the art, taking into account the enlightenment offered by way of the written description contained in applicant's specification, would determine that the broadest reasonable meaning of the words "Product Template Specification" would be a detailed precise presentation of a product guide. Kent discloses a detailed precise presentation of a product guide in the form of a pattern having a defined shape and precise color characteristics that is to be placed onto a textile substrate. This product guide or "Product Template Specification" is acquired by scanner 65, Fig. 1 and values thereof are specified in the data structure stored in the computer-readable data transmission medium of computer 68. With regard to claim 85, applicant defines the data structure as containing data specifying a "Target SKU" which applicant defines as a Product Specification Template after all design input from the user has been made (i.e. at the end of a customization process). The patent to Kent states that upon receiving an input signal from scanner 65, the computer may be used to alter or edit the scanned image prior to generating the input signal 56. Thus the product guide or "Product Template Specification" of Kent has been edited according to design input from the user. Accordingly Kent's Product Template Specification, after being edited, meets the definition for a Target SKU as defined by applicant.

Claims 84 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 86 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kent. It would have been obvious to omit data specifying non-user-specified elements since it has been held that the omission of an element and its function is obvious if the function of the element is not desired; see *Ex parte Wu*, 10 USPQ 2031 (Bd. Pat. App. & Inter. 1989).

The following is an examiner's statement of reasons for allowance:

Claim 1 and the claims which depend thereon are allowable because the prior art does not teach or fairly suggest a process comprising the steps of assembling on a computer terminal a desired subject image and any desired artistic enhancements into a digitally-defined target design and transmitting, using an electronic communications link, said digitally-defined target design to a remotely-located patterning device comprising an array of liquid colorant applicators.

Claim 38 and the claims which depend thereon are allowable because the prior art does not teach or fairly suggest a system comprising a software interface for enabling remote access to an image manipulation design tool, by a user at a design terminal, over a public communications network, an access device by which a subject image may be

functionally acquired by said image manipulation design tool, said tool enabling a user to customize said digitally-defined subject image with the addition of artistic enhancements to form a digitally-defined target design, and a dithering algorithm by which a dithered image may be generated from said digitally-defined target design using a dithering palette of colors and a patterning device control system for transforming said dithered image into appropriate instructions for the actuation of colorant applicators.

Claim 60 and the claims which depend thereon are allowable because the prior art does not teach or fairly suggest an method comprising the steps of providing a user with remote access to an image manipulation design tool over a public communications network, importing a digitized image selected by said user into said image manipulation design tool, enabling said user to customize said digitized image to form a desired target design, and generating actuation instructions for color applicators associated with said patterning apparatus.

Claims 67 and the claims which depend thereon are allowable because the prior art does not teach or fairly suggest a system comprising a computer software interface device providing access to a remotely-located image manipulation design tool over a public communications network, an Internet-based communication presented to said computer software interface device for enabling user selection of a digitized image and initiating input of a select image as a desired target image to said image manipulation tool, and a mechanism receiving a generated order over said public communications network and generating appropriate dispensing instructions for color applicators necessary to reproduce a dithered image on a substrate.

Claims 71 and the claims which depend thereon are allowable because the prior art

does not teach or fairly suggest a method comprising providing a user with access to an image manipulation design tool over a public communications network, providing a review and selection process by which a user can review and incorporate into a custom design, on a trial basis, a plurality of candidate artistic elements, which may include subject images and artistic enhancements, allowing a user to utilize said image manipulation design tool to modify a final selection of said elements to form a custom target image to be transferred to a textile substrate, and communicating said target image to an automated patterning apparatus.

Claims 82 is allowable because the prior art does not teach or fairly suggest a computer readable medium containing instruction data for patterning a textile substrate by the selective application of a plurality of colorants, wherein said pattern data is generated by providing a user with access to a database containing a plurality of pre-defined candidate artistic elements, which may include subject images and artistic enhancements, capable of being incorporated into a custom design, and allowing a user to utilize an image manipulation design tool to modify a final selection of candidate artistic elements to form a custom target image to be transferred to a textile substrate.

Claims 84 is allowable because the prior art does not teach or fairly suggest a computer readable medium containing instructions for patterning a textile substrate by the selective application of a plurality of colorants wherein said pattern data is generated by providing a user with access to a database containing a plurality of pre-defined candidate artistic elements, which may include subject images and artistic enhancements, capable of being incorporated into a custom design, and allowing a user to utilize an image manipulation design tool to modify a final selection of candidate

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artistic elements to form a custom target image to be transferred to a textile substrate.

The drawings are objected pursuant to 37 CFR 1.84 since Figures 3-16 are color drawings. Color photographs and color drawings are acceptable only for examination purposes unless a petition filed under 37 CFR 1.84(a)(2) is granted permitting their use as acceptable drawings. In the event that applicant wishes to use the drawings currently on file as acceptable drawings, a petition must be filed for acceptance of the color photographs or color drawings as acceptable drawings. Any such petition must be accompanied by the appropriate fee set forth in 37 CFR 1.17(h), three sets of color drawings or color photographs, as appropriate, and, unless already present, an amendment to include the following language as the first paragraph of the brief description of the drawings section of the specification:

The patent or application file contains at least one drawing executed in color. Copies of this patent or patent application publication with color drawing(s) will be provided by the Office upon request and payment of the necessary fee.

Color photographs will be accepted if the conditions for accepting color drawings have been satisfied.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter P Nerbun whose telephone number is 703-308-0955. The examiner can normally be reached on M-F (1st Week) M-Th (2d Week).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John J Calvert can be reached on 703-305-1025. The fax phone number for the organization where this application or proceeding is assigned is 703-308-0758.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-

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0861.

Peter Nerbun
January 8, 2004

A handwritten signature in black ink, reading "Peter Nerbun". The signature is written in a cursive style with a large, looping "P" and a trailing flourish.

Peter Nerbun
Primary Examiner